UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,947	12/07/2001	L. Michael Maritzen	Sony-00700	7595

7590   04/23/2003

Valley Oak Law
5655 Silver Creek Valley Road, #106
San Jose, CA   95138

EXAMINER
ABDI, KAMBIZ

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 04/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>07 December 2001</u> .

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-47</u> is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-47</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>07 December 2001</u> is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5</u> .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: .

DETAILED ACTION

1.   Claims 1-47 have been examined.

Drawings

2.   The drawings filed on 7 December 2001, are acceptable subject to correction of the

informalities indicated on the attached "Notice of Draftperson's Patent Drawing Review," PTO-

948. In order to avoid abandonment of this application, correction is required in reply to the Office

action. The correction will not be held in abeyance.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4.   Claims 1-22, 26-36, and 40-47 are rejected under 35 U.S.C. 102 (b) being anticipated by

U.S. Patent No. 5,892,900 to Karl L. Ginter et al.

5.   As per claim 1, Ginter clearly discloses a transaction system comprising:

- a transaction device having a storage device wherein the transaction device

  is configured for interfacing with a user;

- embedded content residing within the storage device of the transaction

  device,

- wherein the embedded content is available to the user in response to a

  verification within the transaction device.

(See Ginter figures 5A, 5B and associated text, and column 3, lines 30-68, column 4, lines 1-68,

and column 5, lines 1-41)

6.   As per claim 2-13, Ginter discloses all the limitations of claim 1, further;

Ginter discloses,

- a backend module configured for tracking a location of the embedded content (See Ginter column 4, lines 44-68),

- wherein the embedded content contains audio data (See Ginter column 9, lines 3-20, column 27, lines 44-68, and column 32, lines 24-68),

- wherein the embedded content contains visual data (See Ginter column 27, lines 44-68, and column 32, lines 24-68),

- wherein the embedded content contains a financial balance of the user (See Ginter column 11, lines 22-68, and column 12, lines 1-65),

- wherein the embedded content contains credit data of the user (See Ginter column 33, lines 36-65, and column 35, lines 13-53),

- wherein the embedded content contains a location history of the embedded content (See Ginter column4, lines 5-68, and column 6, lines 14-29, and column 45, lines 15-68),

- wherein the embedded content contains a current location of the embedded content (See Ginter column 14, lines 25-48, and column 45, lines 15-68),

- wherein the embedded content contains encryption information (See Ginter column 12, lines 3-44),

- wherein the embedded content contains ownership information related to the embedded content (See Ginter column 10, lines 23-31, and column 135, lines 20-34),

- wherein the embedded content contains textual data (See Ginter column 23, lines 21-35),

- wherein the embedded content contains graphical data (See Ginter column 23, lines 21-35).

7.   As per claims 14, 29, and 47, Ginter discloses a method and a computer-readable medium comprising;

- receiving embedded content within a transaction device;

- locally verifying within the transaction device an authorization to use the embedded content; and

- utilizing the embedded content in response to the authorization.

- requesting a payment prior to using the embedded content on the transaction device;

- providing the payment from the transaction device in response to requesting the payment; and

- utilizing the embedded content through the transaction device in response to providing the payment.

(See Ginter figures 5A, 5B and associated text, and column 3, lines 30-68, column 4, lines 1-68, column 5, lines 1-41, column 40, lines 62-68, and column 41, lines 1-68).

8.   As per claims 15 and 30, Ginter discloses all the limitations of claims 14 and 29, further; Ginter discloses,

- encrypting the embedded content upon receiving the embedded content within the transaction device (See Ginter figures 5A, 5B and associated text, and column 3, lines 30-68, column 4, lines 1-68, column 5, lines 1-41, column 12, lines 3-44, column 40, lines 62-68, and column 41, lines 1-68).

9.   As per claims 16 and 31, Ginter discloses all the limitations of claims 14 and 29, further; Ginter discloses,

- wherein utilizing the embedded content further comprising decrypting the embedded content (See Ginter figures 5A, 5B and associated text, and column 3, lines 30-68, column 4, lines 1-68, column 5, lines 1-41, column 12, lines 3-44, column 40, lines 62-68, and column 41, lines 1-68).

10.   As per claims 17 and 32, Ginter discloses all the limitations of claims 14 and 29, further;

Ginter discloses,

- encrypting the embedded content in response to not verifying the authorization (See Ginter figures 5A, 5B and associated text, and column 3, lines 30-68, column 4, lines 1-68, column 5, lines 1-41, column 11, lines 58-68, column 12, lines 1-60, column 40, lines 62-68, column 41, lines 1-68, and column 48, lines 34-64).

11.   As per claims 18 and 33, Ginter discloses all the limitations of claims 14 and 29, further; Ginter discloses,

- transmitting a payment from the transaction device to a vendor based on the embedded content (See Ginter figures 5A, 5B and associated text, and column 3, lines 30-68, column 4, lines 1-68, column 5, lines 1-41, column 40, lines 62-68, column 41, lines 1-68, and column 48, lines 34-64).

12.   As per claims 19 and 34, Ginter discloses all the limitations of claims 14 and 29, further; Ginter discloses,

- securely transmitting a payment from the transaction device to a vendor based on the embedded content through a transaction privacy clearing house (See Ginter figures 5A, 5B and associated text, and column 3, lines 30-68, column 4, lines 1-68, column 5, lines 1-41, column 40, lines 62-68, column 41, lines 1-68, and column 47, lines 4-63)

13.   As per claims 20 and 35, Ginter discloses all the limitations of claims 14 and 29, further; Ginter discloses,

transmitting the embedded content from the transaction device to a remote device (See Ginter figures 5A, 5B and associated text, and column 3, lines 30-68, column 4, lines 1-68, column 5, lines 1-41, column 17, lines 18-68, column 18, lines 1-65, column 40, lines 62-68, and column 41, lines 1-68).

14.   As per claims 21, Ginter discloses all the limitations of claims 20, further;

Ginter discloses,

- locally verifying a permission to use the embedded content within the remote device; and

- utilizing the embedded content in response to the permission.

(See Ginter figures 5A, 5B and associated text, and column 3, lines 30-68, column 4, lines 1-68, column 5, lines 1-41, column 17, lines 18-68, column 18, lines 1-65, column 40, lines 62-68, and column 41, lines 1-68).

15.   As per claims 22 and 36, Ginter discloses all the limitations of claims 14 and 29, further; Ginter discloses,

- authenticating usage of the transaction device via a pin code (See Ginter figures 5A, 5B and associated text, and column 3, lines 30-68, column 4, lines 1-68, column 5, lines 1-41, column 40, lines 62-68, column 41, lines 1-68, and column 187, lines 10-47).

16.   As per claims 26, 27, 28, and 40, Ginter discloses all the limitations of claims 14 and 29, further;

Ginter discloses,

- automatically calculating individual payments to multiple vendors based on the embedded content.

- providing the authorization in response to a local verification of sufficient funds within the transaction device.

- providing the authorization in response to a confirmed payment by the transaction device.

(See Ginter figures 5A, 5B and associated text, and column 3, lines 30-68, column 4, lines 1-68, column 5, lines 1-41, column 31, lines 6-26, column 40, lines 62-68, and column 41, lines 1-68).

17.   As per claim 41, Ginter discloses a method comprising:

- transmitting embedded content from a first transaction device to a second transaction device; and

- automatically requesting a payment from the second transaction device to a source of the embedded data in response to the embedded data.

(See Ginter column 3, lines 30-68, column 4, lines 1-68, column 5, lines 1-41, column 11, lines 58-68, column 12, lines 1-60, column 31, lines 6-26, column 40, lines 62-68, column 41, lines 1-68, column 47, lines 4-63, column 55, lines 61-68, and column 56, lines 1-64).

18.   As per claim 42, Ginter discloses all the limitations of claim 41, further;

Ginter discloses,

- transmitting the payment from the second transaction device to the source through a secure financial transaction (See Ginter column 3, lines 30-68, column 4, lines 1-68, column 5, lines 1-41, column 11, lines 58-68, column 12, lines 1-60, column 13, lines 5-68, column 31, lines 6-26, column 40, lines 62-68, column 41, lines 1-68, column 47, lines 4-63, column 55, lines 61-68, and column 56, lines 1-64).

19.   As per claim 43, Ginter discloses all the limitations of claim 42, further;

Ginter discloses,

- wherein the secure financial transaction is routed through a transaction privacy clearing house transmitting the payment from the second transaction device to the source through a secure financial transaction (See Ginter column 3, lines 30-68, column 4, lines 1-68, column 5, lines 1-41, column 11, lines 58-68, column 12, lines 1-60, column 13, lines 5-68, column 14, lines 25-68, column 31, lines 6-26, column 40, lines 62-68, column 41, lines 1-68, column 47, lines 4-63, column 55, lines 61-68, and column 56, lines 1-64).

20.   As per claim 44, Ginter discloses all the limitations of claim 41, further;

Ginter discloses,

- further comprising utilizing the embedded content by the second transaction device (See Ginter column 3, lines 30-68, column 4, lines 1-68, column 5, lines 1-41, column 11, lines 58-68, column 12, lines 1-60, column 13, lines 5-68, column 14, lines 25-68, column 31, lines 6-26, column 40, lines 62-68, column 41, lines 1-68, column 47, lines 4-63, column 55, lines 61-68, and column 56, lines 1-64).

21.   As per claim 45 and 46, Ginter discloses a method comprising:

- receiving embedded content within a transaction device;

- receiving a payment request in response to the embedded content;

- transmitting the payment from the transaction device to a single location;

- receiving a first portion of the payment by a first source of the embedded content; and

- receiving a second portion of the payment by a second source of the embedded content.

- wherein the single location is a transaction privacy clearing house.

(See Ginter figures 5A, 5B and associated text, and column 3, lines 30-68, column 4, lines 1-68, column 5, lines 1-41, column 47, lines 4-63, column 55, lines 61-68, and column 56, lines 1-64)

Claim Rejections - 35 USC § 103

22.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

23.   Claims 23-25 and 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,892,900 to Karl L. Ginter et al.

24.   As per claims 23-25 and 37-39, Ginter discloses all the limitations of claims 14 and 29, Ginter is not specific on disclosing the following,

- authenticating usage of the transaction device via a biometric parameter.

- the biometric parameter is a fingerprint.

- the biometric parameter is an iris scan,

Using authentication parameters in authorizing a user to access certain content or verifying business transactions is well known security practice within the art. To use biometric parameters as means of authentication within the art for high security access transactions is also well known. Few of the most prevalent biometric parameters used in the art are finger prints, voice prints, iris scan, and DNA samples. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to add the well-known practice of using biometric parameters as means of authentication of individual conduction a business transaction for better and higher security practice.

Conclusion

25.   Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

26.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Abdi whose telephone number is (703) 305-3364. The examiner can normally be reached on 9:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the Receptionist whose telephone number is (703)308-1113.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
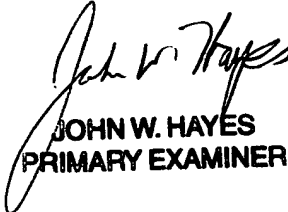Washington, D.C. 20231

or faxed to:

(703) 305-7687 [Official communications; including After Final communications labeled "Box AF"]

(703) 746-7749 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to:

Crystal Park 5, 2451 Crystal Drive
7th floor receptionist, Arlington, VA, 22202

Abdi/K
April 16, 2003

JOHN W. HAYES
PRIMARY EXAMINER